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IN THE
Supreme Court of the United States

OCTOBER TERM, 1976

No. 76-1109

FOSTER GRANT CO., INC.,

Petitioner,

vs.

ILLINOIS TOOL WORKS INC.,

Respondent.

**BRIEF IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI**

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Illinois Tool Works Inc., respondent, respectfully submits that the petition for writ of certiorari should be summarily denied—because petitioner has failed to raise a single issue worthy of review by this Court.

Even though petitioner has presented a highly partisan view of this case, it has been unable to point to any conflict in the circuits, to any conflict between the Seventh Circuit Court of Appeals and this Court, or to any other compelling reason for granting the writ.

The present patent infringement action involves a factual dispute between two private parties. This action was resolved favorably to respondent by the District Court (after a 15 day trial) in a 71 page opinion and by the Seventh Circuit in a unanimous opinion written by Chief Judge Fairchild. By its petition, petitioner merely seeks another appeal!

SUPPLEMENTAL STATEMENT OF THE CASE

The Statement of the Case in petitioner's petition omits or inadequately sets forth the facts. However, the District Court's opinion contains an excellent recital (A.28-44). To avoid unnecessary duplication, this Court is respectfully invited to read this part of the District Court's opinion (A.28-44) before reading the balance of this Brief.

THE QUESTIONS PRESENTED

1. Should this Court review the Rovico Doctrine of the Seventh Circuit Court of Appeals, where both the District Court and the Seventh Circuit Court of Appeals decided the factual and legal issues *without* relying upon the Rovico Doctrine?

2. Should this Court review 35 USC 112 where all of the Circuits, including the Seventh Circuit, have uniformly interpreted 35 USC 112 as to the law—and by applying such uniform interpretation to the facts of this case, the patents in suit fully satisfy 35 USC 112, as found by the District Court and the Seventh Circuit Court of Appeals?

REASONS FOR DENYING THE WRIT

The petitioner presents *no* special, important, unusual, public interest, or compelling reason for granting the writ. None of the petitioner's real issues relate to matters of law, but instead relate to previously resolved issues of fact, none of which calls for the exercise of this Court's supervisory authority.

A. THE SEVENTH CIRCUIT'S ROVICO DOCTRINE IS A STARE DECISIS DOCTRINE

In its Introductory Statement and under its Reasons For Granting The Writ (Pet. pp. 2, 3, 12, 14, 15), petitioner is apparently challenging the Seventh Circuit's Rovico Doc-

trine. The Rovico Doctrine is simply another name for the time-honored doctrine of stare decisis—no more and no less!

The Rovico Doctrine is simply stated: where a patent has been held valid by a first court, a second court may refer to the first court's holding of validity and, then, may require "persuasive new evidence" of invalidity. This doctrine is supported by principles of orderly administration of justice and conservation of judicial time and effort.

The Seventh Circuit is not alone in applying the doctrine of stare decisis to patent infringement actions. Moreover, not only have the other circuits relied upon stare decisis with respect to decisions within their *own* jurisdictions, but also with respect to decisions in *other* jurisdictions. For example:

The Second Circuit, in sustaining the validity of an earlier litigated patent, in *Georgia-Pacific Corp. v. United States Plywood Corp.*, 258 F.2d 124, 133 (2nd Cir. 1958) stated:

"The presumption of validity is reinforced by the history of previous litigation and two decisions of Judge Pierson M. Hall in the District Court for the Southern District of California. . . He had before him at that time not only the file wrapper history but also the Hansen, Morden and Elmendorf patents, Gilmer patent No. 1,943,597, and the Moray panels. . . These considered judgments are entitled to weight on this appeal."

The Third Circuit in *Sutherland Paper Co. v. Grant Paper Box Co.*, 183 F.2d 926, 936 (3rd Cir. 1950) stated:

"Finally we regard it as of considerable importance that this patent has already been held valid by the Court of Appeals for the First Circuit. *Grant Paper Box Co. v. Russell Box Co.*, supra. The public interest in finality of patent validity determinations has not prevailed over established principles of *res judicata*. But that interest is substantial. . ."

The Fifth Circuit, in sustaining the validity of a patent found earlier to be valid, in *Miles v. Matthews*, 171 F.2d 38, 39 (5th Cir. 1948) held:

"We are thus brought to the real question in this case, whether, in view of the fact that additional patents, not part of the record in the trial of the other case, have been offered here requires the court to reconsider and withdraw from its former decision. It is certainly true that that decision is not binding as *res judicata* here. In view, though, of our conclusion that the newly offered patents have not substantially changed the record upon which that decision was grounded, we think it clear that it ought not to be departed from here, and that the judgment appealed from, based, as it was, in part upon that decision should be affirmed."

The Sixth Circuit, in upholding the validity of a previously litigated patent, in *Cold Metal Process Co. v. E. W. Bliss Company*, 285 F.2d 231, 236 (6th Cir. 1960) flatly declared:

"Opponents of the patent also contend that since they were not parties in the Republic Steel case, the ruling is not *res judicata* as to them . . .

In the Republic Steel case this Court had before it rulings in cases in the Third Circuit holding the patent valid. Although it was recognized that they were not controlling upon the ruling of this Court, we took occasion to point out that such prior decision holding the patent valid, even though from a different circuit, should be followed unless the Court was convinced of 'a very palpable error in law or fact,' . . . In the present case in which we have a prior ruling from our own Court, the rule of *stare decisis* is applicable."

Further, the Tenth Circuit, in sustaining the validity of a patent held valid in an earlier suit, in *Williams v. Hughes Tool Co.*, 196 F.2d 278, 281 (10th Cir. 1950) stated:

"[3] Moreover, the decision of the Fifth Circuit in *Robertson Rock Bit Co. v. Hughes Tool Co.*, *supra*, was

rendered upon facts substantially identical with those presented on this record, and that decision, while not binding on this court, is strongly persuasive under the doctrine of comity."

Finally, this Court itself, as early as 1934, embraced the Rovico Doctrine in principle and in application in a patent infringement action. In comparing an earlier suit in *Radio Corporation of America v. Radio Engineering Laboratories, Inc.*, 293 US 1, 6, 8 (1934), this Court stated:

"The evidence in this suit for an infringement is a repetition, word for word, of the evidence in the earlier suits, . . . What has been added is so nearly negligible that to all intents and purposes the records are the same."

After discussing the presumption of validity and the burden of proof needed to overcome the presumption, this Court held:

"From all this it results that a stranger to a patent suit does not avoid altogether the consequences of a judgment rendered in his absence by establishing his privilege under the doctrine of *res judicata* to try the issues over again. If he has that opportunity and there is substantial identity of evidence, he may find that the principle of adherence to precedent will bring him out at the end where he would be if he had been barred at the beginning."

The Seventh Circuit in *Mercantile National Bank of Chicago v. Howmet Corp.*, 524 F.2d 1031, 1032 (7th Cir. 1975), cert. denied, 424 US 957 (1976), merely followed the above statements of this Court when it stated (A. 3):

"For reasons of stability in the law and judicial economy, we ordinarily will not reexamine *de novo* the decision of the court in the prior case but rather will limit ourselves to a consideration of whether, assuming

the correctness of the earlier decision, additional facts not before the court in the prior case require a different result. This is but an application of the doctrine of *stare decisis*."

Thus, it is clear from the above discussion that the Rovico Doctrine is simply an application of *stare decisis* to patent infringement actions. The Rovico Doctrine is squarely premised on the same principles, rationale, and philosophy as is *stare decisis*.

Notwithstanding the validity of the Rovico Doctrine, the District Court pointedly did *not* base its opinion solely on the Rovico Doctrine. First, the District Court acknowledged the Rovico Doctrine in the context of its discussion of the statutory presumption of validity under 35 USC 282. Second, the District Court specifically *ignored* the Rovico Doctrine by stating:

"However, notwithstanding the Rovico rule, this Court has considered the evidence "de novo", i.e., independently from and without reliance upon the prior ITW decisions, and in addition, has considered some new evidence which it has found unpersuasive." (A. 66).

Further, although the Seventh Circuit Court of Appeals did review the Rovico Doctrine (A. 2-5), it did actually make a *de novo* appellate review of the District Court's *de novo* analysis. Indeed, as is readily apparent from its opinion (A. 5-26), the Court of Appeals did specifically review and reject each and every one of petitioner's six "primary errors" and "additional grounds for reversal".

The Court of Appeals did not abbreviate or abort its analysis of the above "errors" or "grounds" by reliance on the Rovico Doctrine—and did not preemptorily dismiss any of petitioner's arguments. On the contrary, the Court of Appeals in a 26 page printed opinion carefully and patiently reviewed each of petitioner's alleged "errors" and

"grounds"—and found each without merit. Based on its judgment, independent of the Rovico Doctrine, the Court of Appeals affirmed the District Court's "de novo" findings.

On page 3 of its petition, petitioner argues that the District Court did not make the "step-by-step analysis required by the Supreme Court in *Graham v. John Deere*", 383 US 1, 17 (1966)—which according to Judge Hanley of the Ninth Circuit must be "rigidly adhered to". The fact is that the Court of Appeals affirmed that the District Court did follow the Supreme Court's "step-by-step analysis", but preferred a more completely literal approach (A. 4).

It is eminently clear that the District Court did in fact rigidly adhere to the Supreme Court's "step-by-step analysis". This is evident from the District Court's opinion itself (A. 65-72) and from the following statement of the District Court directed to the Supreme Court's "step-by-step analysis":

"Having analyzed the scope and content of the prior art, the differences between the prior art and the asserted claims of the '213 patent and '360 patent [and '139 patent], it is concluded that the inventions . . . would not have been obvious. . ." (A. 71, 72).

Thus, contrary to petitioner's contention, the District Court did follow the Supreme Court's "step-by-step analysis" in its "de novo" considerations of the patents in suit.

In summary, the Rovico Doctrine, which was not solely relied upon by the lower courts, provides no basis for granting the writ.

B. THERE IS NO REASON FOR THIS COURT TO REVIEW 35 USC 112 AT THIS TIME WITH THIS CASE

As another reason for granting the writ, petitioner alleges that this Court should reaffirm that its pre-1952 decisions continue to control the "written description"

requirement of 35 USC 112 (Pet. p. 13). Petitioner does *not* contend that a conflict exists between the circuits, that a conflict exists between this Court and the Seventh Circuit, or that any reason set forth in Supreme Court Rule 19 is applicable.

It is a surprising request to ask this Court to reaffirm, when it is generally accepted in the patent field that the 1952 patent statute (title 35) codified the existing patent law (particularly as it relates to the "written description" of 35 USC 112). This request is less tenable than a request for an advisory opinion, which has traditionally been avoided by all courts. Petitioner's request to reaffirm is clearly no reason for granting the writ.

Petitioner urges, as a further reason for granting the writ, that a conflict exists between the First and Sixth Circuits *and* the Seventh Circuit in the interpretation of "best mode" under 35 USC 112 (Pet. Br. p. 13). Petitioner confuses a conflict of results in different factual cases with a conflict of interpretation. Indeed, there is no conflict among the circuits in interpreting "best mode".

Specifically, petitioner relies upon the First Circuit case of *Dale Electronics, Inc. v. RCL Electronics, Inc.*, 488 F.2d 382, 389 (1st Cir. 1973) and the Sixth Circuit case of *Union Carbide Corp. v. Borg-Warner Corp.*, — F.2d —, 193 USPQ 1 (6th Cir. 1977). These cases fail to establish any conflict with the Seventh Circuit.

In the *Dale Electronics* case, the invention *claimed* included a beryllium oxide core for an electrical resistor. The Court found that the patent did not disclose a particular beryllium oxide composition which the inventor knew to be the best composition. The Court properly concluded that the patentee had not disclosed the "best mode" of his invention—and held the patent invalid under 35 USC 112.

It is noteworthy that the First Circuit Court of Appeals in a subsequent case, *ITT v. Raychem Corporation*, 538 F.2d

453 (1st Cir. 1976), clearly indicated that no conflict in the law exists between the First Circuit and the Seventh Circuit. In that case, the First Circuit held that where the omitted data does *not* relate to the claimed invention, the "best mode" requirement of 35 USC 112 is *not* applicable. It did *not* invalidate the patent under 35 USC 112.

In the *Union Carbide* case, on which petitioner relies, the Sixth Circuit plainly indicated that determinations as to "best mode" are purely factual. In that case, the invention claimed was "*a process*" for molding and "the best mode issue involved a valve and an extruder used in apparatus to perform the process." (emphasis in original) — F.2d —, 193 USPQ at 2. In its discussion of the facts found by the trial court, the Sixth Circuit affirmed the finding that the process could be satisfactorily performed only if a "unique valve system" and a "particular kind of extruder" were used. — F.2d —, 193 USPQ at 3-6. Neither essential element of the apparatus for performing the claimed process had been disclosed. Thus, on the unique facts in that case, the Court held there was a failure to disclose the "best mode" and invalidated the patent under 35 USC 112.

But again, the Sixth Circuit pointed out that its opinion is *not* at variance with the views of the Third Circuit, Seventh Circuit, First Circuit, or Court of Customs and Patent Appeals. The Sixth Circuit stated:

"The facts of this case readily distinguish it from *Benger Laboratories Ltd., v. R. K. Laros Co.*, 209 F. Supp. 639 (E. D. Pa. 1962), Aff'd 317 F.2d 455 (3rd Cir. 1963).*** We have no quarrel with the results in the above cited cases. (Referring to Appellant's citation of *Flick-Reedy Corp. v. Hydro-Line Manufacturing Co.*, 351 F.2d 546 (7th Cir. 1965); *In re Gay*, 309 F.2d 769 (CCPA 1962); and *In re Bosy*, 360 F.2d 972 (CCPA 1966)."

(Explanation added.) — F.2d —, 193 USPQ at 7-8.

The Court of Customs and Patent Appeals in *In re Bosy*, 360 F.2d 972, 976 (CCPA 1966), cited with approval by the Sixth Circuit, casts light on petitioner's erroneous position that the alleged failure to disclose the "best mode" of details unrelated to the claimed invention violates 35 USC 112. The Court of Customs and Patent Appeals stated:

"It is our view that the error of failing to 'analyze exactly what appellant's invention is in the instant case,' *In re Gay*, supra, 50 CCPA at 732, 309 F.2d at 773, has resulted in the additional error of requiring a best mode be set forth of details not relating to the essence of the invention. What would be sufficient as a best mode here cannot be determined until first the invention is discerned." (Emphasis added). *Id.* at 976.

Plainly, the Sixth Circuit, as well as the First Circuit, the Seventh Circuit, and the Court of Customs and Patent Appeals, agree with the established law on "best mode".

Petitioner has failed to show any inconsistent interpretations of the "best mode" requirement of 35 USC 112 between the above circuits and the Seventh Circuit. Significantly, as established by the above authorities, this is not a "best mode" case. But even if it were, there is no conflict among the circuits—and no reason to grant the writ.

C. THE LITIGATION HISTORY OF RESPONDENT'S PATENTS IN THE SEVENTH CIRCUIT IS NO REASON FOR GRANTING THE WRIT

Petitioner urges the Court to grant certiorari because of the concentration of suits in the Seventh Circuit, i.e., the seven decisions sustaining the validity of respondent's patents all occurred within the Seventh Circuit (Pet. p. 14). In support of its position, petitioner relies upon *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 US 47, 50 (1938) and *Exhibit Supply Co. v. Ace Patents Co.*, 315 US 126, 128 (1942).

Respondent submits that the above decisions are readily distinguishable from the present case. In the most recently decided case, i.e., the *Exhibit Supply* case, this Court emphasized that certiorari was granted because of "the nature of the questions presented" and "the industry affected . . . is located in" a single circuit. In contrast, in the present case there is no question presented worthy of review by this Court; moreover, the nestable container industry "is not located" in the Seventh Circuit, but is scattered throughout the United States.

In the *Schriber-Schroth* case, this Court granted the petition because of "the doubtful validity of the patents" and again because the industry affected was located in one circuit. Neither of these facts is present in this case. Significantly, the patents in suit have been held valid by three different District Court judges and three different appeal panels of the Seventh Circuit. In addition to its 12 U.S. licensees, respondent has had 11 foreign licensees under foreign counterpart patents. These licensees reflect the world-wide recognition of the commercial value of the inventions and the validity of the patents in suit.

Contrary to the above cases on which petitioner relies, the nestable container industry comprises many manufacturers, not all of which are in any way affected by the litigation in the Seventh Circuit. Moreover, the 12 licensee companies are licensees because they elected to be. All manufacture and/or sell nestable containers for which a license has not been obtained and is *not* needed. Solo Cup, for example, has converted its entire line of nestable containers to non-infringing designs. Actually, petitioner, itself, has been making and selling a line of nestable containers which do not require a license.

In short, the above cases are clearly distinguishable from the present case and, as such, no basis exists for granting the writ.

D. PETITIONER MERELY SEEKS ANOTHER APPEAL OF THE BASICALLY FACTUAL "SUBSTANTIVE ISSUES"

In its petition (Pet. pp. 15-22), petitioner urges this Court to review what are basically factual issues between two private litigants. These factual issues were carefully and fully considered by the District Court and the Court of Appeals—and resolved adversely to petitioner. Petitioner has had its day in Court and is not entitled to yet another appeal.

In regard to petitioner's "*Estoppel as to the '213 Patent*" issue (Pet. pp. 15-17), this is the same file wrapper estoppel issue that was fully rejected by the District Court and Court of Appeals. Moreover, as now presented to this Court, petitioner's position is difficult to understand. As understood, petitioner seems to be contending that respondent distinguished over the patents cited by the Patent Office in such a way as to limit or restrict the scope of claim 1. Petitioner's argument fails, because petitioner's high-profile commercial container (the accused container) is not like any of the patents cited by the Patent Office.

Specifically, it is evident from the '213 patent and its file history that claim 1 defines respondent's container invention over a container having a *rim* stacker. In a problem-prone *rim* stacker, the rim structure itself comprises the upper stacking shoulder and *no shelf or support structure* is provided apart from and spaced below the rim, as defined in claim 1.

In contrast to the prior art containers having prior *rim* stackers, petitioner's high-profile container (PX-63) has its Z-shaped stacking ring provided as a separate element located apart from and spaced below the rim exactly as found by the District Court (A. 63). As stated by the Court of Appeals in the *ITW v. Continental Can* case, 397 F.2d 517, 518, when describing respondent's '213 containers: "When stacked, the *lower shelf* of the top ring of

one cup is supported on the *upper shelf* of the top ring of the next lower cup. The result is that when stacked, only the surfaces of the shelves are engaged . . ." (Emphasis added). As admitted by petitioner, its high-profile container (PX-63) has these shelves and it is these shelves, not the rim, which provide the operative stacking function.

The prosecution histories, contrary to petitioner's contention, unequivocally establish that the '213 claims were *not* allowed after having been amended to distinguish over a container having a "high profile" type of stacking ring of the type embodied in petitioner's current commercial containers. Petitioner's current commercial cups embody respondent's invention and *not* any of the "prior art" constructions. There is *no* file wrapper estoppel in the classical sense or in any other sense.

Contrary to the suggestion of petitioner (Pet. p. 17), the Rovico Doctrine has nothing to do with petitioner's file wrapper estoppel or due process arguments. Petitioner's file wrapper estoppel argument is without merit.

In regard to petitioner's "*A Combination of Old Elements in '213*" issue (Pet. pp. 17-19), this issue has been flatly rejected not only by the District Court, 273 F. Supp. 94,—but also by the U.S. Patent Office—which fully considered and rejected the combination of Flack and Aldington as now proposed by petitioner for the first time in this case. After relying upon thirty-eight prior art patents and publications, and four alleged public uses relative to the '213 and '360 patents before the District Court—and after relying upon *only* four alleged prior art cups and three patents in fifteen different combinations in challenging the validity of the '213 and '360 patents before the Court of Appeals, petitioner now returns to the Flack and Aldington patents originally cited and rejected by the Patent Office. Petitioner has come "full circle" and now relies upon these patents *to which the statutory presumption of validity relative to the '213 and '360 patents fully applies!*

The proposed combination is simply an "after the fact" piecemeal approach to reconstruct respondent's inventions—developed by counsel in light of the teachings of respondent's patents and without any suggestion from the prior art.

Considering more specifically the above patents, the Flack patent was applied by the Examiner against the application claims, but after further prosecution, the Examiner allowed the claims over the Flack patent. The Flack patent is essentially *another form of rim stacker*. If the shoulder 5 is not considered to be the rim but a part of the stacking means, then the remaining rim part 7 is incomplete and is not of "increased lateral width" as defined by the asserted claims.

The reason why the Flack patent was discarded by the Patent Office, is that the wall portion 4 of Flack is *vertically* disposed, thus presenting the undesirable rigidity inherent in a vertical wall cylinder. The Flack patent does not provide the stacking ring of the type defined by the claim of the '213 patent.

The Aldington patent was applied by the Examiner against the application claims, but after further prosecution, the Examiner allowed the claims over the Aldington patent. This patent discloses a non-analogous plastic lid adapted to snap on a container. The container has no stacking ring and, thus, provides a form of "sidewall nesting" which respondent's container invention seeks to avoid.

The lids of Aldington are just that—lids, and not containers at all. The problems presented to lid designers are totally different from those solved by respondent's container inventions. For example, in a lid, the stacker is used to provide vertical spacing of the skirts, unlike cups in which the sidewalls are vertically nested and dimensioned to avoid jamming in packaging, shipping and handling. Further, there is no reference in the Aldington patent to resiliency of a stack of lids (273 F. Supp. at p. 114).

The Aldington lids do not provide a sidewall of "substantial height" *within which* a stacking facility is embodied. On the contrary, the stacking facility is *substantially the entire sidewall* if it be regarded as such. Further, the Aldington lids do not provide a sidewall which can be gripped by a user; rather, the lid is adapted to be gripped by the skirt of its rim.

Petitioner argues that the Aldington lids are "flexible and resilient", but admits that these properties are "not directly mentioned in Aldington's discussion about stacking". It is precisely the stacking structure which is in issue—and Aldington's failure to identify the stacking structure as resilient strongly suggests that it was not.

In an attempt to inject resiliency into the Aldington lids, petitioner refers to tests of alleged Aldington lids—which the District Court correctly held were of "limited probative value". Indeed, these tests were run on simulated, alleged prior art devices. None of these devices were available in 1957, 1958, or before. On the contrary, they were manufactured from materials not available in 1957-58, on machinery not available in 1957-58, and by thermoforming processes not used in 1957-58. Consequently, these "after the fact" tests conducted for the purpose of this lawsuit have nominal, if any, probative value—and certainly cannot remedy a deficiency in the Aldington lid. *Carson v. American Smelting & Refining Co.*, 4 F.2d 463, 465-66 (9th Cir. 1925).

Petitioner's attempt to reconstruct the claimed invention in a piecemeal fashion—even though there is no suggestion from either the Flack or Aldington patents that this could be done—is without merit.

As a last argument, petitioner contends that the "combination of elements defined in the '213 claims produces no 'synergistic effect' or any other 'nonobvious' result" (Pet. p. 19). On the contrary, the '213 claims do define a patentable combination with synergism, not an aggregation of old elements. As stated above, the Aldington lid does not disclose the claimed stacking ring, so there is no aggregation

of *old* elements. Moreover, the claimed elements, i.e., the side wall, the bottom, the rim, and the stacking facility are all integrally formed as a unit, with each interacting with an adjacent element to produce a resultant synergistic structure having a "sum greater than the total of the individual parts".

This sharply contrasts with the *Anderson's-Black Rock* and *Sakraida* cases, on which petitioner relies, where the claimed combination comprised separate and unrelated components acting independently and separately from one another—a classic unpatentable aggregation of old elements. Clearly, respondent's claimed subject matter satisfies this Court's synergistic and unobvious tests as set forth in *Graham v. John Deere Co.*, 383 US 1, 17 (1966); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc.*, 396 US 57, 61-62 (1969); and *Sakraida v. Ag Pro. Inc.*, 425 US 273, 280-83 (1976). Petitioner's argument is without merit.

In regard to petitioner's "*The Section 112 Requirements*" issue (Pet. pp. 19-21), this issue relating to the term "rim" was thoroughly reviewed and rejected by the District Court and the Court of Appeals. Petitioner objects to "rim" not appearing in the specification of the '213 patent, but does admit that "rim" is used in the parent specification (on which the '213 specification is based).

With this admission, the inquiry is whether the specifications of the '213 patent (parent and divisional) are sufficient "to enable one skilled in the art to practice the 'inventions' defined by the asserted claims". The answer is yes—one skilled in the art clearly could make or build the claimed inventions.

Petitioner also refers to corollary issues under 35 USC 120 and 121 and contends that the same invention must be "disclosed in both applications", i.e., the parent and '213 applications. Actually, the same inventions are disclosed in both the parent and the '213 applications. It is uncontested that both applications disclose in their respective drawings identical figures using identical reference numerals to iden-

tify identical parts of the '213 cup embodiment. Moreover, in the parent application, for the '213 cup embodiments the term "lip" (not "rim or lip") is used to describe the upper part of the '213 cup, in exactly the same manner as the '213 patent application.

The term "lip" was always used for the '213 cup embodiments which further evidences that the same inventions were disclosed in both the parent application and the '213 application. Since there is clearly common subject matter disclosed in both applications as discussed above, the same invention is disclosed in both applications—and 35 USC 112 and 120 are fully satisfied. Petitioner's argument has no merit.

Petitioner finally complains about respondent's failure to disclose what petitioner calls a "rolled rim" in the '213 patent specification. This complaint ignores the simple fact that a "rolled rim" is *not* set forth in the claims of the '213 patent—and the "best mode" requirement of 35 USC 112 is not even in point, *In re Bosy, supra*. Further, even if a "rolled rim" were set forth in the claims of the '213 patent, the "rolled rim" could not be considered as the "best mode", in view of the widespread alternative and known use of either *rolled* or *unrolled* rims in the many areas of the container field.

At trial there was no testimony that rolled rims are necessary. Indeed, there was no testimony whatsoever on this point, because it was not in issue. However, in the *ITW v. Solo* case, it was in issue and was rejected. Testimony was presented that "Many cups today are used in Canada without a rolled rim". (179 USPQ at 369). Petitioner argues that respondent should have disclosed its commercial form of vending cups. However, the patents in suit are not limited to vending cups and, in any event, the commercial form of vending cups need not be disclosed.¹ *Armstrong v.*

¹ As a matter of fact, respondent's method of making vending cups, shown in the '213 patent, was disclosed in the Politis patents issued in 1955 and 1956.

Motorola, Inc., 374 F.2d 764, 771 (7th Cir. 1967); *Application of Gay*, 309 F.2d 769, 773 (CCPA 1972); *Benger Laboratories Ltd. v. R. K. Laros Co.*, 209 F. Supp. 639, 644 (E. D. Pa. 1972); *ITW v. Solo*, *supra* at 366-69.

Moreover, the claims of respondent's patents define a container made by the thermoforming process. This thermoforming process does not produce a container with a "rolled rim", but instead a rim construction exactly as is illustrated in the drawings of the patents in suit. The thermoformed rim is "rolled" as a separate step by separate rim rolling equipment. In short, respondent's claims define the complete "article" made by the thermoforming process used throughout the industry. Petitioner's argument is without merit.

In regard to petitioner's "*That Which Infringes If Later Anticipates If Earlier*" issue (Pet. pp. 21-22), this issue was twice considered *de novo* by the District Court and Court of Appeals—and both times found wanting. Petitioner, somewhat stubbornly, continues to assert that the Kent Plastic's development anticipates or renders obvious the claims of respondent's '139 patent.

The evidence clearly established that in the Kent package there were three seals *downstream* from the vents in the lid. Because of this construction, the package will not vent when the lid is placed on the container to form the package. This structure sharply contrasts with respondent's '139 invention in which the seal is *upstream* from the vents in order to permit the package to seal, vent, and reseal when the lid and container are in assembled relation. Claim 1 of the '139 patent requires that the "holding and venting means portion" be "*downstream* of said sealing means portions". Thus, the Kent package is the opposite of respondent's '139 invention, as embodied in both respondent's packages and petitioner's accused packages.

Petitioner complains that the District Court refused to admit into evidence the Continental Can packages. As a

result, petitioner suggests it was unable to make a comparison of the Kent and Continental Can packages. Petitioner's arguments are unfounded. First, petitioner itself objected to the introduction of the Continental Can package and has no standing to now claim error. Second, the Continental Can packages *were in evidence* (PX-151 and 157) and were available for comparison. Third, the Kent and Continental Can packages *were fully compared* and discussed by both of the parties in their briefs before the District Court (see petitioner's Post Trial Brief, pp. 63-64, and respondent's Reply Brief, p. 39).

Petitioner's contention that the Kent package and the Continental Can package are the same is totally without merit. This is clear from the holding in the *Continental Can* case that "the Continental Can lid has an integral holding and venting means which is located '*downstream*' from the sealing means", *ITW v. Continental Can*, 273 F. Supp. 129 (emphasis added). In contrast to the Continental Can lid (and package), the Kent lid (and package) has its venting means located "*upstream*" from the sealing means, as has been fully discussed above.

Indeed, the Kent package has multiple seals *downstream* from the vents, while the Edwards package, the ITW package, the Continental Can package, and the Foster Grant package each has its sealing positions *upstream* from the vents. This distinction produces an entirely different package operation. The Kent package neither anticipates nor renders obvious the '139 invention. Petitioner's contention is erroneous.

In regard to petitioner's "*A Combination of Old Elements in '139*" (Pet. pp. 22-23), petitioner continues to assert that the Kent Plastics development anticipates "each and every element of the '139 venting patent", even though both the District Court and Court of Appeals found to the contrary.

The simple fact is that petitioner relied and now relies *solely* on the Kent Plastics development—which does not

employ the elements defined in the asserted claims. Thus, contrary to petitioner's contention, the defined elements are not "old" and cannot comprise an unpatentable aggregation of "old" elements.

Parenthetically, respondent's inventor developed a package which was unobvious to and beyond the technical capabilities of Kent Plastic personnel. Respondent's inventor as a preliminary effort and Kent Plastics personnel as a final effort designed a lid to prevent trapped air during capping, but neither solved the lid-popping problem until respondent's inventor took the unusual step, which Kent Plastics did not. Respondent's inventor developed a self-venting package with a seal *upstream* from the vents, which package would seal, vent and reseal after the lid was placed on the container. This inventive package solved the lid-popping problem, but the Kent Plastics package did not.

Petitioner finally contends that the claims of the '139 patent lack synergism. On the contrary, each of the claimed elements are integrally formed as a cohesive unit, with each interacting with the other to produce a resultant synergistic construction. Indeed, the claimed subject matter of the '139 patent is totally different from the unrelated and separate elements which act independently of one another in the claims invalidated by the Court in *Ander-son's-Black Rock* and *Sakraida, supra*.

Petitioner's contention is without merit.

CONCLUSION

This case does not involve any unsettled questions of law. There are no conflicts among the circuits or between the Seventh Circuit and this Court. There are no matters presented which call for the exercise of this Court's supervisory authority. Indeed, this controversy involves only a factual dispute between two private litigants.

In summary, there is *no* special, important, or compelling reason for granting a writ of certiorari. The petition should be summarily denied.

Respectfully submitted,

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Certificate of Service

This will certify that six (6) copies of the foregoing BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI were hand-delivered to the offices of C. Frederick Leydig, Esq. and Berton Scott Sheppard, Esq., Leydig, Voit, Osann, Mayer & Holt, Ltd., One IBM Plaza—Suite 4600, Chicago, Illinois 60611, on this 27th day of April, 1977.

Granger Cook, Jr.